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EXAMINER
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL J. DOVE

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Appeal 2008-0566  
Application 10/053,292  
Technology Center 3600

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Decided: May 8, 2008

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Before MURRIEL E. CRAWFORD, JENNIFER D. BAHR, and LINDA E.  
HORNER, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Michael J. Dove (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 5-6 and 8-16. Claims 1-4 and 7 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

## THE INVENTION

Appellant's invention is directed towards an extension pole formed by a plurality of pole segments 10 where each pole segment includes a first tube portion 30 and a second tube portion 20 (Spec. 4, ¶ 6 and figs. 1-2)<sup>1</sup>. The first tube portion 30 includes an insert 34 and a push button 32 mounted to a spring 33 (Spec. 4, ¶ 8). The second portion 20 includes an aperture 21 and has an internal diameter that is larger than the external diameter of the second portion 30 (Spec. 4, ¶ 6). When assembling the extension pole, the first tube portion 30 of a first pole segment 10 is inserted into the second tube portion 20 of a second pole segment 10 by receiving push button 32 into aperture 21 (Spec. 4, ¶ 6). Hence, the extension pole can be formed by sequential assembling of multiple pole segments 10 without removing the rubber insert 34 during assembly (Spec. 4, ¶ 8).

Claim 5 is illustrative of the claimed invention and reads as follows:

5. An extension pole arrangement comprising successively joined pole segments, each pole segment being substantially identical and comprising:

first and second tube portions, the first tube portion extending longitudinally from the second tube portion and terminating with an end cap;

the second tube portion having an open end with an inside diameter greater than the outside diameter of the first tube;

wherein the first tube portion of a first pole segment is received into the second tube portion of a second pole

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<sup>1</sup> The references we make to the Specification are directed towards the substitute specification filed on February 20, 2004.

segment, so that the extension pole is formed with the end cap of the second pole segment formed without removal of the end cap from the first pole segment;

the first tube portion including a locking mechanism configured for coaxing mating engagement with an aperture in said second tube portion for receiving said locking mechanism.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Siebert	US 2,712,950	Jul. 12, 1955
Eichhorn	US 5,779,386	Jul. 14, 1998
Lah	US 6,557,572 B2	May 6, 2003

The following rejections are before us for review:

Claims 9-16 stand rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as being indefinite.

Claims 5, 6, 8-10, 12-14, and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Siebert in view of Lah.

Claims 11 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Siebert in view of Lah and in further view of Eichhorn.

The Examiner provides reasoning in support of the rejections in the Answer (mailed December 19, 2006). Appellants present opposing arguments in the Appeal Brief (filed May 23, 2006) and the Reply Brief (filed January 18, 2007).

FACTS

*Siebert*

We make the following findings of fact with respect to Siebert:

1. Siebert discloses an extension pole (handle 5) made from multiple sections 6, 7, 8, and 9 (pole segments) (col. 2, ll. 8-9 and fig. 1).
2. Pole segments 7, 8, and 9 have a dowel portion 10 (first portion) (smaller diameter portion), whereas pole segments 6, 7, and 8 have a socket portion 11 (second portion) (larger diameter portion). The socket portion has an inside diameter larger than the outside diameter of the dowel portion (col. 2, ll. 18-22 and fig. 2).
3. Socket portions 11 are adapted to telescopingly receive dowel portions 10 (col. 2, ll. 20-21; fig. 2).
4. The socket portion includes lugs 19 that mate with openings 16 located on the dowel portion (col. 2, ll. 48-59 and figs. 4-5).
5. Although Siebert teaches an end cap 12 on the socket portion of the last pole segment 9 (col. 2, ll. 22-23 and fig. 1), Siebert does not teach that the end cap is on the dowel portion of each pole segment 6, 7, 8, and 9.

*Lah*

We make the following findings of fact with respect to Lah:

6. Lah teaches a tent pole (extension pole) having multiple segments 50 and 60 (col. 4, ll. 4-15; figs. 4, 5).
7. The pole segment 60 includes a first portion and a second portion 61, wherein the external diameter of the second portion 61 is smaller than the internal portion of the second segment 50 (col. 3, ll. 4-10 and fig. 4).

8. When assembling the tent pole, the second portion 61 of the pole segment 60 is received in the second segment 50 (col. 3, ll. 11-16 and fig. 5).
9. The second portion 61 of the pole segment 60 includes a finishing member (end cap) 90.
10. The purpose of adding the finishing member 90 (cap) is to avoid damage to the pole segments when assembling the pole segments 50 and 60 (col. 4, ll. 31-37).
11. The outer diameter of the finishing member 90 (end cap) is the same as the outer diameter of the second portion 61 of pole segment 60 (figs. 5 and 6).

### OPINION

#### *The Indefiniteness Rejection*

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). A claim may be invalid for indefiniteness if it is "insolubly ambiguous" and not "amenable to construction." *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001).

Claim 9 recites, "...the extension pole is formed with the cap of the second pole segment formed without removal of the cap..." (underlining added). Similarly, claim 13 recites, "...the extension pole is formed with the cap of the last pole segment added formed without removal of the cap..."

(underlining added). The Examiner's basis for the rejection, as articulated on page 4 of the Answer, is that "[t]his appears to be a method step of actual formation of the cap, as oppose[d] to a structural limitation."

We fully appreciate the Examiner's criticism of the claim language alluded to in the rejection. As pointed out by the Examiner, it appears to relate to the formation, or manufacture, of one of the end caps itself. The language implies that the end cap of one pole segment is actually formed or constructed without removal of the end cap of another pole segment from its corresponding pole segment, which does not appear to make sense when read in a vacuum. The definiteness of claim language, however, must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). When read in light of the Appellant's Abstract, which teaches that as each additional tube is added, the rubber insert (cap) is always at the end of the tube, the discussion of the disadvantages of the prior art (Spec. 2-3, ¶ 3), and the discussion of "sequential connection of multiple extension poles 10 without removal of the insert 34" (Spec. 4, ¶ 8), we find that a person of ordinary skill in the art would appreciate that the end cap received in the second [last] pole segment is distinct from the end cap of the first [any other] pole segment. Such a person would further understand the limitation in claims 5<sup>2</sup>, 9, and 13 at issue in the indefiniteness rejection to mean that the extension pole is formed, or assembled, with an end cap being received into a first portion of a second [last] pole segment, without removal of the end cap from the first

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<sup>2</sup> Although the Examiner has not rejected claim 5 and claims 6 and 8 depending from claim 5 as indefinite, claim 5 includes similar language.

[any other] pole segment. In light of the above, we conclude that claims 9 and 13 are not "insolubly ambiguous" and are "amenable to construction." It follows that claims 9 and 13 are not indefinite. Therefore, the rejection of claims 9 and 13, and claims 10-12 and 14-16 that depend from claims 9 and 13, respectively, cannot be sustained.

*The obviousness rejection under Siebert in view of Lah*

The Appellant argues claims 5, 6, 8-10, 12-14, and 16 rejected under 35 U.S.C. § 103(a) together as a group. Therefore, in accordance with 37 C.F.R. 41.37(c)(1)(vii), we have selected claim 5 as the representative claim to decide the appeal of the obviousness rejection, with claims 6, 8-10, 12-14, and 16 standing or falling with claim 5.

The issue presented in this appeal is whether the Appellant has demonstrated that the Examiner erred in determining that the subject matter of claims 5, 6, 8-10, 12-14, and 16 is unpatentable over Siebert in view of Lah.

The Examiner contends that it would have been obvious for one of ordinary skill in the art to insert the cap of Lah in the dowel portion (first portion) of the pole segment of Siebert in order to prevent damage to the pole segments upon assembly of the extension pole (Ans. 5-6). In response, the Appellant argues that "Siebert teaches insertion of a smaller diameter pole into a larger diameter existing pole," whereas the instant invention teaches "positioning of a larger diameter pole over the smaller diameter end of an existing pole" (App. Br. 9) (underlining in original). The Appellant's argument is not persuasive, because claim 5 does not require a step of positioning a larger diameter pole over a smaller diameter end of an existing



pole. Limitations not appearing in the claims cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Rather, claim 5 requires that the first tube portion of the first pole segment be received into the second portion of a second pole segment. Siebert teaches such an arrangement. Specifically, Siebert teaches that the dowel portion (the first, smaller diameter portion) of segment 7 is received in the socket portion (the second, larger diameter portion) of segment 6 (Findings of Fact 2 and 3). .

The Appellant further argues that the combination of Siebert and Lah is improper because “it is far too simplistic” to suggest that the purpose of modifying the extension pole of Siebert with the cap of Lah is to provide “a buffering structure that would prevent damage to other pole elements” (App. Br. 10). The Appellant argues that the claimed invention “provides for the formation of an extension pole assembly...without the removal of the protective end cap” (App. Br. 11).

If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007). In determining whether the subject matter of a claim is obvious, “neither the particular motivation nor the avowed purpose of the [applicant] controls. What matters is the objective reach of the claim.” If the claim extends to what is obvious, it is unpatentable under § 103. *Id.* at 1741-42. Moreover, while there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account

of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741.

In this case, Lah specifically teaches that the purpose of adding the finishing member 90 (end cap) is to avoid damage to the pole segments when assembling the pole segments 50 and 60 (Finding of Fact 10). A person of ordinary skill in the art would appreciate that such a finishing member (end cap) would provide the same benefit during the assembly of the extension pole of Siebert. Moreover, the Appellant has not alleged, much less shown, that modification of Siebert to provide such a finishing member (end cap) would have been beyond the skill of a person of ordinary skill in the art.

The Appellant also argues that the combination of Siebert and Lah is improper because the finishing member (end cap) of Lah: (1) does not constitute an “end cap” because it includes a through hole 91 and does not terminate or end another object (App. Br. 12) and (2) cannot be used in conjunction with the dowel portion of Siebert because it would block the open end of the longitudinally extending groove 13, hence blocking the lug 19 from connecting with opening 16 (App. Br. 10 and Reply Br. 10).

With regard to the Appellant’s first point, accepting the Appellant’s proffered definition of an “end cap” as “something that terminates or ends [an]other object” (App. Br. 12), we find that Lah’s finishing member 90 constitutes an “end cap” for the second portion 61 of the pole segment 60. We find nothing in the limitation of an “end cap” that precludes the end cap from including a through hole. As shown clearly in Figures 5 and 6 of Lah, the finishing member 90 terminates or ends the second portion 61 of the pole segment 60, and would likewise terminate or end the dowel portion of pole

segments 7 and 8 of Siebert when incorporated therein as proposed by the Examiner. Accordingly, the finishing member 90 of Lah constitutes an “end cap.”

Regarding Appellant’s second point, the Examiner contends that the finishing member (end cap) of Lah “is merely a plug into the opening of each pole segment, and minor changes to the plug design to accommodate the connection element 19 of Siebert would be an obvious change in shape” (Ans. 8). We agree with the Examiner because obviousness does not require that all the features of the secondary reference be bodily incorporated into the primary reference. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Moreover, the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984). After all, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR*, 127 S.Ct. at 1742. We note that because the outer diameter of the finishing member is the same as the outer diameter of the second portion (Finding of Fact 11), we find that it would not be difficult for one of ordinary skill in the art to provide a finishing member (end cap) that has a cross-sectional shape matching that of the dowel portion of the pole segment in the handle of Siebert as modified in view of Lah such that blockage of the longitudinally extending groove 13 does not occur as the Appellant has suggested.

The Appellant also argues that “each pole segment of the Siebert device is not substantially the same” (Reply Br. 8-9). We find this argument to be unpersuasive. Claim 5 requires “successively joined pole segments” that are “substantially identical.” Siebert specifically discloses that pole

segments 7 and 8 are successively joined and include both a dowel portion and a socket portion (Finding of Fact 2). We find no disclosed differences between the pole segments 7 and 8 of Siebert and thus find them to be “substantially identical,” as required by claim 5. We further note that the transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376 (Fed. Cir. 2004). Therefore, in addition to pole segments that are “substantially identical,” the extension pole of Siebert may also include pole segments that are not “substantially identical” and still satisfy the limitations of claim 5.

For the foregoing reasons, the Appellant’s arguments do not persuade us the Examiner erred in rejecting claim 5 as unpatentable over Siebert in view of Lah. The rejection of claim 5, and claims 6, 8-10, 12-14, and 16 standing or falling with claim 5, is sustained.

*The obviousness rejection under Siebert in view of Lah and in further view of Eichhorn*

The Appellant’s arguments in favor of patentability of claims 11 and 15 as unpatentable over Siebert in view of Lah and in further view of Eichhorn (Br. 13) simply rely on the arguments asserted as to claim 5 and are thus unpersuasive for the reasons discussed above with respect to claim 5. We therefore affirm the rejection of these claims as well for the reasons discussed above with respect to claim 5. The rejection is sustained.

SUMMARY

The decision of the Examiner to reject claims 9-16 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as being indefinite is reversed.

The decision of the Examiner to reject claims 5-6, 8-10, 12-14, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Siebert in view of Lah is affirmed.

The decision of the Examiner to reject claims 11 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Siebert in view of Lah and in further view of Eichhorn is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

JRG

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